

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/724,020
Filed: November 26, 2003
Inventor(s):
Stephen C. Evans and David
Stuart Gordon

Title: NETWORK COMPONENT
IDENTIFICATION

Examiner: Lim, Krisna
Group/Art Unit: 2153
Atty. Dkt. No: 5681-74800
Conf. No. 7260

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Erik A. Heter

Printed Name

/Erik A. Heter/

Signature

5/1/06
Date

REQUEST FOR PRE-APPEAL BRIEF REVIEW

ATTN: BOX AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

REMARKS

Claims 1-12 and 14 are currently pending in the application. Claims 1-12 and 14 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Garrett, U.S. Patent 6,877,033. Applicant respectfully submits that this rejection is erroneous for at least the following reasons.

Applicant respectfully submits that the Examiner is applying an interpretation to the limitation “component of a computer network” that is broader than reasonable and not consistent with the specification. Applicant further submits, that, in the ‘Response to Arguments’ section of the final office action, the Examiner is conflating the term “network components” with “circuit components.”

Applicant’s independent claim 1 recites: “A method of generating identification information relating to a component of a computer network having an associated memory storing a first set of data items relating to the component, comprising retrieving one or more of said first set of data items from said associated memory and generating said identifying information from said retrieved data items. (Emphasis added).” Similarly, Applicant’s independent claim 7 recites, in pertinent part: “A method of operating a computer network including a first network component and a second network component linked to the first network component by a communication network, the second network component being operable to perform a network management application wherein a request for identification information is sent via the communications network to the first network component ...” (emphasis added).

In the office action, the Examiner contends that Garrett teaches the limitation of “generating identification information relating to a component of a computer network” in col. 1, lines 24-25 and in col. 4, lines 4-5. In col. 4, lines 1-5, Garrett teaches the following: “Based on the requirements information, a component determination module 112 determines the components that could be used to build a circuit that would satisfy the specified requirements, and generates one or more “suggested component” web pages.” (Emphasis added). In col. 1, lines 22-25, Garrett states: “To avoid having to pay the marked up prices that would be required by a third party, the user may attempt to become educated on circuit design, and obtain parts catalogs from circuit component suppliers. (Emphasis added).” Clearly, the components referred to by Garrett and cited by the Examiner are components of an electronic circuit. Furthermore, these are not even actual electronic components, but rather, information related to or

representative of electronic components. Thus, Garrett does not teach “a component of a computer network.”

The Examiner continues by citing Fig.'s 5A-5G as teaching the memory in the limitation “a component of a computer network having an associated memory.” However, Fig's 5A-5G merely teach web pages that display information related to circuit components that are selected for the electronic circuit. Accordingly, the components taught by Garrett do not have a memory per se. For example, the component to which Fig's. 5A-5G are directed is an LM2575 step-down voltage regulator. Voltage regulators are well known in the art, and do not have memories, much less having “an associated memory storing a first set of data items relating to the component.”

In equating a circuit component as taught by Garrett with a “component of a computer network” recited in the independent claims, the Examiner has interpreted this limitation in an overly broad manner. MPEP 2111 states the following: “During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard: The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1).” (Emphasis added). Thus, in equating a circuit components of Garrett with the “component of a computer network” recited in the independent claims, the Examiner has interpreted the claims in a manner that is not consistent with the specification. Furthermore, one of ordinary skill in the art would not equate the components taught by Garrett, which are components to be used in an electronic circuit, with “a component of a computer network.” Accordingly, the Examiner is interpreting the claims in a manner in which the claims would not be interpreted by one of ordinary skill in the art in light of the specification.

In the ‘Response to Arguments’ section of the final office action, the Examiner states: “[given] the broadest reasonable interpretation of the claimed language, Garrett clearly [discloses]

the teaching two network components linked together (e.g., Internet, 130, of Fig. 1, the abstract).” In light of this statement, Applicant respectfully submits that the Examiner is conflating two different types of components. The components cited by the Examiner are not coupled to the Internet, nor do they transmit information across the internet to other like components. Furthermore, as noted above, the components cited by the Examiner are not actual components, but rather, information related to or representative of electronic components. Thus, the components cited by the Examiner are not components that “[provide] identification information in response to such a request [from a another network component,” “[generate] said identification information from said retrieved data items [retrieved from a memory associated with the component],” and [send] generated identification information to [the other] network component via said communications network.” Therefore, by citing the Internet in the ‘Response to Arguments’ section, the Examiner is conflating the electronic circuit components taught by Garrett with components that are actually part of the Internet and are capable of transmitting information to and receiving information from other components that are also part of the Internet.

Applicant further notes that merely disclosing the Internet is not sufficient to teach a “component of a computer network” as recited in claim 1 or a “first network component” and a “second network component” in claim 7, including those additionally recited limitations associated with these network components. MPEP 2131 states: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >” (Emphasis added). MPEP 2131 further states: “The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).”

Thus, for at least the reasons stated above, Applicant respectfully submits that the Examiner is applying an overly broad interpretation to the limitations recited in the claims, and that such an interpretation is consistent with the specification as it would be interpreted by one of ordinary skill in the art. Accordingly, the Examiner’s rejection does not meet the requirements for claim interpretation outlined in MPEP 2111. Applicant further submits that the Examiner is conflating claim terminology in the final office action, while failing to show that the cited reference teaches each and every element as set forth in the claim, arranged as required by the claim. Thus, the Examiner’s has not established a case of anticipation in accordance with MPEP 2131. Finally, Applicant submits that Garrett fails to teach or suggest all of the elements of the

independent claims. For at least these reasons, Applicant respectfully submits that the Examiner's rejection is erroneous, and respectfully requests reversal thereof.

CONCLUSION

Applicants submit the application is in condition for allowance, and an early notice to that effect is requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-74800/EAH.

Respectfully submitted,



Erik A. Heter
Reg. No. 50,652
AGENT FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8800

Date: 8/1/08